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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/911,856 | 07/25/2001 | David H. Mack | 003848.00091 | 4786 |

28315 7590 09/16/2002

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EXAMINER

ALLEN, MARIANNE P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1631

DATE MAILED: 09/16/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/911,856 | MACK, DAVID H. | |
| | Examiner | Art Unit | |
| | Marianne Allen | 1631 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-107 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant is advised that no claim 4 was originally presented. The original claims were numbered 1-3 and 5-108. Claims 5-108 have been renumbered as 4-107 in keeping with 37 CFR

1.126. The dependency of the original claims has been corrected as needed.

Parent application 09/341,302 was filed under 35 U.S.C. §371 and the lack of unity set forth in that application is set forth below.

This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

- I. Claims 1-9 and 106-107, directed to a method for mapping.
- II. Claims 10-16, directed to a method for detecting functional mutation.
- III. Claims 17-23, directed to a method for determining function.
- IV. Claims 24-27, directed to a second method for determining function.
- V. Claims 28-32, directed to a method for detecting p53 function.
- VI. Claims 33-37, directed to an in-cell p53 assay.
- VII. Claims 38-39, directed to a device.
- VIII. Claims 40-42, directed to a second method for detection.
- IX. Claim 44, directed to a method for analysis.
- X. Claim 45, directed to a third method for detection.
- XI. Claims 45-69, directed to a method of determining cell loss.
- XII. Claims 70-93, directed to a method of diagnosis.
- XIII. Claims 94-97, directed a method of identifying drugs.
- XIV. Claims 98-105, directed to a solid support.

The inventions listed as Groups I-XIV do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I forms a single inventive concept and contains claims directed to a first appearing method. This first appearing method possesses no special technical feature as prior art can be applied against the claims of Group I and a special

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technical feature must define a contribution over the prior art. (See at least reference to Schena cited on search report and applied in IPER.) Groups VII and XIV are drawn to structurally different products which do not share the same or a corresponding special technical feature. Groups II-VI and VIII-XIII are drawn to different methods having different goals, method steps, and starting materials which do not share the same or a corresponding special technical feature. Note that PCT Rule 13 does not provide for multiple products or methods within a single application.

Because these inventions do not relate to a single inventive concept under PCT Rule 13.1 as set forth above, restriction for examination purposes as indicated is proper.

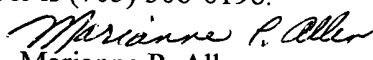
Due to the number of inventions in the lack of unity requirement, no attempt was made to obtain a telephonic election.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen, whose telephone number is (703) 308-0666. The examiner can normally be reached on Monday-Friday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028. Official FAX communications may be directed to either (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Marianne P. Allen
Primary Examiner
Art Unit 1631

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September 11, 2002